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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK E. PECEN, SANJAY GUPTA, and STEPHEN L. SPEAR

Appeal 2009-002598
Application 10/804,292
Technology Center 2600

Decided: January 20, 2010

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and ELENI
MANTIS MERCADER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1, 3-10, 12-18, 20-27, and 29-34, which are all of the pending claims. Claims 2, 11, 19, and 28 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed September 18, 2007), and the Answer (mailed January 3, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision.

Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to the handover of a communication device between first and second networks while the communication device is engaged in an ongoing communication. The communication device can send a transfer request to the first network to request a handover of the ongoing communication between the first and second networks without interrupting the ongoing communication. (*See generally* Spec. 7:6–8:14).

Claim 1 is illustrative of the invention and reads as follows:

1. A method in a communication device for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network, the method comprising:

entering an ongoing communication on the first radio access network;

detecting a presence of a second radio access network, the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication; and

transferring the ongoing communication from the first radio access network to the second radio access network,

wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network.

The Examiner's Rejections

The Examiner relies on the following prior art references to show unpatentability:

Ovesjo	US 2002/0160785 A1	Oct. 31, 2002
Stumpert	US 2004/0157600 A1	Aug. 12, 2004 (filed Oct. 19, 2001)
Shaheen	US 2004/0203792 A1	Oct. 14, 2004 (filed Nov. 14, 2002)
Boyer	US 7,050,812 B2	May 23, 2006 (filed Jan. 9, 2004)
Yahagi	US 7,065,360 B2	Jun. 20, 2006 (filed Jan. 30, 2002)

Claims 1, 3, 4, 7, 8, 18, 20, 24, and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Shaheen.

Claims 5, 6, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaheen in view of Boyer.

Claims 9 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaheen in view of Stumpert.

Claims 10, 16, 17, 21, 27, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaheen in view of Ovesjo.

Claims 12, 14, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaheen in view of Ovesjo and Boyer.

Claims 13, 15, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaheen in view of Ovesjo and Yahagi.

ISSUES

The pivotal issues before us are whether Appellants have demonstrated that the Examiner erred in finding that:

- a) Shaheen discloses the detection of the presence of a second radio access network that is unregistered with a first radio access network at the time of the initial detection, and
- b) the identification values associated with a serving cell of a first radio network and received in a measurement report as disclosed in Shaheen and Ovesjo correspond to the claimed fictitious neighbor values.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Appellants disclosed invention relates to the handover of a communication device between first and second networks while the communication device is in an ongoing communication. The communication device includes a network detection module which is configured to detect the presence of a second radio access network which is unregistered with the first radio access network at the time of detection. (Spec. 4:22-31).
2. Appellants also disclose that the second radio access network can be considered to be unregistered with the first radio access network in the sense that i) the first radio access network is unaware of the second radio access network, ii) that neither network can exert control over each other, or iii) each radio access network may not recognize the other radio access network as a radio access network. (Spec. 4:31-5:4).

3. Appellants further disclose the transmitting between first and second networks of a handover transmission which can include a measurement report including a fictitious neighbor value. (Spec. 7:26-29).

4. Appellants also disclose that the fictitious neighbor value “can be an identifiable value associated with the serving cell,....” (Spec. 7:29-30).

5. Shaheen discloses a system and method for handoff between a wireless local area network (WLAN) and a universal mobile telecommunication system (UMTS). A list of available WLANs is broadcast by the UMTS 12 for reception by the UMTS receiver 10a’ in the user equipment UE 10’. (Shaheen, Fig. 7, steps S1-S8, ¶¶ [0039]-[0040]).

6. Shaheen further discloses (Fig. 7, steps S9-S16, ¶¶ [0041]-[0043]) that, upon the targeting of a specific WLAN by the UMTS, the UMTS locks onto the WLAN channel to initiate the WLAN service and the WLAN authenticates the user equipment UE 10’ and grants access to the WLAN receiver 10b’ of the user equipment UE 10’.

7. Ovesjo discloses (Fig. 3, ¶¶ [0032], [0039], and [0040]) a method and system for handover of a communication between first and second radio access networks that use different radio access technologies. A measurement report message is sent from mobile terminal (MT) 30 to base station controller (BSC) 26.

PRINCIPLES OF LAW

1. ANTICIPATION

“It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim.” *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986); *Lindemann*

Maschinenfabrik GMBH v. Am. Hoist & Derrick Co., 730 F.2d 1452, 1457 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (*id.*).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l. Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(e) REJECTION

Appellants’ arguments in response to the Examiner’s anticipation rejection, based on Shaheen, of independent claims 1 and 18 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Shaheen so as to establish a *prima facie* case of anticipation. Appellants’ arguments (App. Br. 11-13) focus on the contention that, in contrast to the requirements of independent claims 1 and 18, Shaheen does not disclose the detection of the presence of a second radio access network which is *unregistered* with the first radio access network at the time of detection. According to Appellants, in Figure 7 of Shaheen, referenced by the Examiner, the UMTS 12 (the first radio access network) broadcasts a list of available WLANs 14 (second radio access network). Appellants argue, therefore, that there must be a registration of WLANs, initially, by the UMTS receiver 10a’ in the user equipment UE 10’ since the WLANs would have to be registered with the UMTS in order for the UMTS to broadcast the list of available WLANs.

We do not find Appellants’ arguments to be persuasive of any error in the Examiner’s stated position (Ans. 3, 4, 15, and 16). We agree with the

Examiner that, giving the claim language the broadest reasonable interpretation in light of Appellants' disclosure, the detected WLAN 14 in Shaheen does not become *registered* with the UMTS 12 until selection is made (step S9) and authentication take place (step S14). Until authentication takes place, neither the WLAN nor the UMTS can exert control over each other which, according to Appellants' disclosure (FF 2), is an example of an *unregistered* condition.

Appellants' further arguments relying on the Figure 4 embodiment of Shaheen in support of their position are equally unpersuasive. Unlike Shaheen's Figure 7 embodiment in which the UMTS 12 broadcasts a list of available WLANs 14, the Figure 4 embodiment of Shaheen does not involve a broadcast but, rather, relies on the monitoring of WLAN channel power levels by the UMTS receiver 10a' to lock onto an appropriate WLAN channel.

While Appellants' arguments (App. Br. 13) recognize that authentication of the WLAN system with the user equipment UE is disclosed (Fig. 4, steps S7 and S8, ¶¶ [0031]-[0032]) as taking place after initial WLAN detection, Appellants nonetheless contend that, in order for authentication to occur, Shaheen's WLAN network would inherently have to be registered with the UMTS network. We find no evidence on the record before us to support such a conclusion. As with our previous discussion with regard to Shaheen's Figure 7 embodiment, we find no error in the Examiner's finding that the WLAN 14 does not become registered with the UMTS 12 until authentication takes place since, until that time, neither network can exert control over each other in accordance with what Appellants' disclosure considers to be a registration (FF 2).

In view of the above discussion, since Appellants have not demonstrated that the Examiner erred in finding that all of the claimed limitations are present in the disclosure of Shaheen, the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1 and 18, as well as dependent claims 3, 4, 7, 8, 20, 24, and 25 not separately argued by Appellants, is sustained.

35 U.S.C. § 103(a) REJECTIONS

We also sustain the Examiner's obviousness rejections of claims 5, 6, 9, 10, 12-17, 21-23, 26, 27, and 29-34. Appellants' arguments in the Brief are directed solely to independent claims 10 and 27 which the Examiner has rejected based on the combination of Shaheen and Ovesjo. Appellants' arguments do not attack the Examiner's basis for combining Shaheen and Ovesjo but, rather, contend that neither Shaheen nor Ovesjo discloses the use of a "fictitious neighbor value" in a measurement report received by a first radio access network. In particular, Appellants contend (App. Br. 15-16) that the quality value used for triggering of a handover disclosed at paragraphs [0037] and [0038] of Ovesjo, relied upon by the Examiner, is an actual value and not a fictitious value.

We do not find Appellants' arguments persuasive in convincing us of any error in the Examiner's stated position. We find that the Examiner (Ans. 9 and 17) has broadly, but reasonably, interpreted the claimed "fictitious neighbor value" as requiring only the receipt of a network cell identification value such as disclosed at steps S1-S3 and S7-S8 in Figure 7 of Shaheen and the network identification values included in the measurement report disclosed by Ovesjo in Figure 3 and paragraphs [0037] and [0038]. This

interpretation is in accordance with Appellants disclosure (FF 4) of a “fictitious neighbor value” as one which “can be an identifiable value associated with the serving cell....”

CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 1, 3, 4, 7, 8, 18, 20, 24, and 25 for anticipation under 35 U.S.C. § 102(e), nor in rejecting claims 5, 6, 9, 10, 12-17, 21-23, 26, 27, and 29-34 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner’s decision rejecting claims 1, 3, 4, 7, 8, 18, 20, 24, and 25 under 35 U.S.C. § 102(e) and claims 5, 6, 9, 10, 12-17, 21-23, 26, 27, and 29-34 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

gvw

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